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1302.14 Reasons for Allowance [R-5] - 1300 Allowance and Issue

1302.14 Reasons for Allowance [R-5]

37 CFR 1.104 Nature of examination.

(e) *Reasons for allowance.* If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims of the application or patent under reexamination or be the subject of a separate communication to the applicant or patent owner. The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication.

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I. < REASONS FOR ALLOWANCE

One of the primary purposes of **37 CFR 1.104(e)** is to improve the quality and reliability of issued patents by providing a complete file history which should clearly reflect, as much as is reasonably possible, the reasons why the application was allowed. Such information facilitates evaluation of the scope and strength of a patent by the patentee and the public and may help avoid or simplify litigation of a patent.

The practice of stating the reasons for allowance is not new, and the rule merely formalizes the examiner's existing authority to do so and provides applicants or patent owners an opportunity to comment upon any such statement of the examiner.

It should be noted that the setting forth of reasons for allowance is not mandatory on the examiner's part. However, in meeting the need for the application file history to speak for itself, it is incumbent upon the examiner in exercising his or her responsibility to the public, to see that the file history is as complete as is

reasonably possible. }

When an application is finally acted upon and allowed, the examiner is expected to determine, at the same time, whether the reasons why the application is being allowed are evident from the record.

Prior to allowance, the examiner may also specify allowable subject matter and provide reasons for indicating such allowable subject matter in an Office communication.

In determining whether reasons for allowance should be recorded, the primary consideration lies in the first sentence of **37 CFR 1.104(e)** which states:

If the examiner believes that the record of the prosecution as a *whole* does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. (Emphasis added).

In most cases, the examiner's actions and the applicant's replies make evident the reasons for allowance, satisfying the "record as a whole" proviso of the rule. This is particularly true when applicant fully complies with **37 CFR 1.111 (b)** and (c) and **37 CFR 1.133(b)**. Thus, where the examiner's actions clearly point out the reasons for rejection and the applicant's reply explicitly presents reasons why claims are patentable over the reference, the reasons for allowance are in all probability evident from the record and **no** statement should be necessary. Conversely, where the record is not explicit as to reasons, but allowance is in order, then a logical extension of **37 CFR 1.111** and 1.133 would dictate that the examiner should make reasons of record and such reasons should be specific.

Where specific reasons are recorded by the examiner, care must be taken to ensure that statements of reasons for allowance (or indication of allowable subject matter) are accurate, precise, and do not place unwarranted interpretations, whether broad or narrow, upon the claims. The examiner should keep in mind the possible misinterpretations of his or her statement that may be made and its possible effects. Each statement should include at least (1) the major difference in the claims not found in the prior art of record, and (2) the reasons why that difference is considered to define patentably over the prior art if either of these reasons for allowance is not clear in the record. The statement is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not be written to specifically or impliedly state that all the reasons for allowance are set forth. Where the examiner has a large number of reasons for allowing a claim, it may suffice to state only the major or important reasons, being careful to so couch the statement. For example, a statement might start: "The primary reason for the allowance of the claims is the inclusion of the limitation in all the claims which is not found in the prior art references," with further amplification as necessary.

Stock paragraphs with meaningless or uninformative statements of the reasons for the allowance should not be used. It is improper to use a statement of reasons for allowance to attempt to narrow a claim by providing a special definition to a claim limitation which is argued by applicant, but not supported by a special definition in

the description in cases where the ordinary meaning of the term in the prior art demonstrates that the claim remains unpatentable for the reasons of record, and where such claim narrowing is only tangential to patentability. Cf. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 741, 62 USPQ2d 1705, 1714 (2002). The statement of reasons for allowance by the examiner is intended to provide information equivalent to that contained in a file in which the examiner's Office actions and the applicant's replies make evident the examiner's reasons for allowing claims.

Examiners are urged to carefully carry out their responsibilities to see that the application file contains a complete and accurate picture of the Office's consideration of the patentability of the application.

Under the rule, the examiner must make a judgment of the individual record to determine whether or not reasons for allowance should be set out in that record. These guidelines, then, are intended to aid the examiner in making that judgment. They comprise illustrative examples as to applicability and appropriate content. They are not intended to be exhaustive.

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II. < EXAMPLES OF WHEN IT IS LIKELY THAT A STATEMENT SHOULD BE ADDED TO THE RECORD

(A) Claims are allowed on the basis of one (or some) of a number of arguments and/or affidavits presented, and a statement is necessary to identify which of these were persuasive, for example:

(1) When the arguments are presented in an appeal brief.

(2) When the arguments are presented in an ordinary reply, with or without amendment of claims.

(3) When both an affidavit under **37 CFR 1.131** and arguments concerning rejections under **35 U.S.C. 102** and 103 are presented.

(B) First action issue:

(1) Of a noncontinuing application, wherein the claims are very close to the cited prior art and the differences have not been discussed elsewhere.

(2) Of a continuing application, wherein reasons for allowance are not apparent from the record in the parent case or clear from preliminary filed matters.

(C) Withdrawal of a rejection for reasons not suggested by applicant, for example:

(1) As a result of an appeal conference.

(2) When applicant's arguments have been misdirected or are not persuasive alone and the examiner comes to realize that a more cogent argument is available.

- (3) When claims are amended to avoid a rejection under **35 U.S.C. 102**, but arguments (if any) fail to address the question of obviousness.
- (D) Allowance after remand from the Board of Patent Appeals and Interferences.
- (E) Allowance coincident with the citation of newly found references that are very close to the claims, but claims are considered patentable thereover:
- (1) When reference is found and cited (but not argued) by applicant.
- (2) When reference is found and cited by examiner.
- (F) Where the reasons for allowance *are* of record but, in the examiner's judgment, are unclear (e.g., spread throughout the file history) so that an unreasonable effort would be required to collect them.
- (G) Allowance based on a claim interpretation which might not be readily apparent, for example:
- (1) Article claims in which method limitations impart patentability.
- (2) Method claims in which article limitations impart patentability.
- (3) Claim is so drafted that "nonanalogous" art is not applicable.
- (4) Preamble or functional language "breathes life" into claim.
- (H) Allowance following decision by the United States Court of Appeals for the Federal Circuit or District Court of the District of Columbia. The reasons for allowance should refer to and incorporate the briefs and the court decision.
- (I) Where the claims are considered patentable over the X and/or Y references cited in a search report of a corresponding PCT application and the reasons for allowance are not apparent from the record.

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III. < EXAMPLES OF STATEMENTS OF SUITABLE CONTENT

- (A) The primary reason for allowance of the claims is the inclusion of .03 to .05 percent nickel in all of the claims. Applicant's second affidavit in example 5 shows unexpected results from this restricted range.
- (B) During two telephonic interviews with applicant's attorney, Mr..... on 5/6 and 5/10/77, the examiner stated that applicant's remarks about the placement of the primary teaching's grid member were persuasive, but he pointed out that applicant did not claim the member as being within the reactor. Thus, an amendment doing such was agreed to.
- (C) The claims in the application are deemed to be directed to an nonobvious